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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,030	06/01/2001	Michael Vitale	1504-0068	1872

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EXAMINER

LAYE, JADE O

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 07/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,030

Applicant(s)

VITALE ET AL.

Examiner

Jade O. Laye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/1/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 6/1/01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

Drawings

2. The drawings are objected to because Figure 1 does not contain sufficient descriptive labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 13, 14, 20-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Severt et al. (US Pat. No. 5,432,705).

Claim 1 recites a method of performing work on a communications system in accordance with a work assignment, comprising limitations too numerous to recite herein. (Please refer to claim sheet). Severt et al disclose a system and method which identifies a data file associated with a work assignment (i.e., trouble ticket) and equipment location, prepares test parameters based upon said location and ticket information, communicates said test parameters to a test device (can be pre-stored or downloaded from a central server), and employs said test device to perform various tests based upon defined test parameters. (Abstract; Col. 2, Ln. 27-Col. 3, Ln. 35; Col. 4, Ln. 26-42). Severt et al go on to disclose transmission of customer names and other customer info, but, fail to specifically disclose identifying the data file in connection with “program” subscription information. However, Applicant’s claims do not limit subscription information to such an interpretation. Therefore, the Examiner broadly interprets Severt’s “customer name and other customer information” to encompass Applicant’s “subscription information.” Accordingly, it would have been obvious at the time of Applicant’s invention to one of ordinary skill in this art to modify the suggested teaching of Severt et al to encompass transmission of subscription information in order to provide a more detailed work order assignment, thereby facilitating a more efficient field visit.

[**Note:** In the alternative, the Examiner takes Official Notice that, at the time of Applicant’s invention, it was notoriously known in the art for cable network providers to store customer subscriber information. (As evidenced by *Beyers, II et al*, US Pat. No. 5,155,590 Col. 10, Ln. 51-62 & *Strickland et al*, US Pat. No. 5,956,024 Fig. 1.).]

Claims 13, 14, and 20-22 correspond to and/or are encompassed within the limitations of claim 1. Thus, each is analyzed and rejected as previously discussed.

Claim 24 recites the method of claim 22, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt et al disclose all limitations of claim 22, and further teach that, at the time applicant's invention, it was well known in the art to correlate work orders with location information and to transmit this information to hand held devices. (Col. 1, Ln. 11-39). Based upon this disclosure, it would have been obvious (if not inherent) for a field technician to enter a work order number and receive the location of the customer. Therefore, the modified system of Severt et al discloses the limitation of claim 24.

4. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Severt et al in view of Beyers, II et al. (US Pat. No. 5,155,590).

Claim 2 recites the method of claim 1, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt et al disclose all limitations of claim 1, but fail to teach the limitation of claim 2. However, within the same field of endeavor, Beyers show it was well known in the art of cable communications for content providers to store subscriber records containing information such as customer names/addresses and pay services the subscriber is authorized to view. (Col. 10, Ln. 51-62). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of Applicant's invention to combine the system of Severt and the teaching of Beyers in order to provide a detailed work order assignment, thereby facilitating a more efficient field visit.

Claim 15 corresponds to the method claim 2. Thus, it is analyzed and rejected as previously discussed.

5. Claims 3-10, 14, 16-19 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Severt et al in view of Wichelman et al. (US Pat. No. 6,853,932).

Claim 3 recites the method of claim 1, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt et al disclose all limitations of claim 1, but fail to teach the limitation of claim 3. However, within the same field of endeavor, Wichelman et al disclose a similar system wherein test parameters specify which channel frequencies are to be tested. (Abstract; Col. 2, Ln. 29-Col. 3, Ln. 2 & Ln. 15-25). Accordingly, it would have been obvious to one of ordinary skill in this art at the time of Applicant's invention to combine the system of Severt and Wichelman in order to provide a remote system for testing individual channels.

Claims 16 and 25 correspond to the method claim 3. Thus, each is analyzed and rejected as previously discussed.

Claims 4 and 5 recite the method of claims 3 and 1, respectively, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, the combined system of Severt and Wichelman discloses all limitations of claims 3 and 1, and Wichelman further teaches the use of a pass/fail parameter (i.e., threshold limits). (Col. 13, Ln. 48-Col. 14, Ln. 3). Accordingly, the combined teachings of Severt and Wichelman disclose all limitations of claims 4 and 5.

Claim 17 corresponds to the method claim 4. Thus, it is analyzed and rejected as previously discussed.

Claims 6 and 7 recite the method of claim 3, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, the combined systems of Severt and Wichelman disclose all limitations of claim 3, and Wichelman further teaches identification of channel frequencies to be tested. (Col. 2, Ln. 49-Col. 3, Ln. 1-6). Accordingly, the combined teachings of Severt and Wichelman disclose all limitations of claims 6 and 7.

Claim 18 corresponds to the method claim 6, while claims 19 and 26 correspond to the method claim 7. Thus, each is analyzed and rejected as previously discussed.

Claims 8 and 9 recite the method of claim 7, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, the combined systems of Severt and Wichelman disclose all limitations of claim 7, and Wichelman further teaches testing analog and digital parameters. (Col. 11, Ln. 55-Col. 12, Ln. 12.). Accordingly, the combined teachings of Severt and Wichelman disclose all limitations of claims 8 and 9.

Claim 10 recites the method of claim 1, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt discloses all limitations of claim 1, but fails to teach the limitation of claim 10. However, Wichelman further teaches the utilization of forward and return paths via the use of modems. (Col. 1, Ln. 52-56). Moreover, at the time of applicant's invention, the use of cable modems was well known in telecommunications networks. Accordingly, the combined teachings of Severt and Wichelman disclose all limitations of claim 10.

Claim 27 corresponds to the method claim 10. Thus, it is analyzed and rejected as previously discussed.

6. Claims 11, 12, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Severt et al in view of Heins et al. (US Pat. No. 5,528,660).

Claims 11 and 12 recite the method of claim 1, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt discloses all limitations of claim 1, but fails to teach the limitations of claims 11 and 12. However, within the same field of endeavor, Heins discloses a similar system wherein test parameters are transmitted via a wireless communication medium. (Abstract & Fig. 1). Moreover, as evidenced by *Ellis et al*, US Pat. Pub. No. 2005/0028208 Par. [0094] and Fig. 1, it was well known at the time of Applicant's invention to utilize the internet for bi-directional communications between base stations and remote devices. Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Severt and Heins in order to provide a remote testing via the use of an alternate communications protocol.

Claims 28 and 29 corresponds to the method claims 12 and 11, respectively. Thus, each is analyzed and rejected as previously discussed.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Severt et al in view of Thibadeau et al. (US Pat. No. 5,432,542).

Claim 23 recites the method of claim 22, further comprising limitations which will not be recited herein. (please refer to claim sheet). As discussed above, Severt discloses all limitations of claim 22, but fails to teach the limitations of claim 23. However, within the same field of endeavor, Thibadeau et al disclose a cable television system which generates a location identifier based upon GPS coordinates. (Col. 14, Ln. 42-60). Accordingly, it would have been obvious to

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one having ordinary skill in this art at the time of Applicant's invention to combine the systems of Severt and Thibadeau in order to provide a system which could identify the location of unstationary network components.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Voght et al (US Pat. No. 5,867,206) disclose a remote testing system.
- b. Estep et al (US Pat. No. 6,353,313) disclose a remote testing device.
- c. Mohammadian et al (US Pat. No. 6,385,300) disclose a remote testing device.
- d. McCain et al (US Pat. No. 5,309,351) disclose a remote testing unit.
- e. Budinger et al (US Pat. No. 6,802,032) disclose a remote system for performing diagnostics on cable modem systems.
- f. Keyes et al (US Pat. No. 6,516,427) disclose a remote diagnostic facility.
- g. Chang et al (US Pat. No. 5,619,489) disclose a hand held testing device.
- h. Martin et al (US Pat. No. 5,357,519) disclose a diagnostic system.
- i. Chang et al (US Pat. Pub. 2003/0048756) disclose a telecommunications testing device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner's Initials JK
June 20, 2005.


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600